

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant | : Robin Pou et al. | Art Unit | : 3621 |
| Serial No. | : 10/726,284 | Examiner | : John M. Winter |
| Filed | : December 2, 2003 | Conf. No. | : 5291 |
| Title | : DISTRIBUTION AND RIGHTS MANAGEMENT OF DIGITAL CONTENT | | |

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Please consider the references listed on the enclosed PTO-1449 form. Cited U.S. patents and patent application publications will be provided on request. A copy of a Spanish Language communication from a foreign patent office in a counterpart application is also enclosed.

It is presently our understanding that the Spanish Language Office Action issued in Pending Mexican Patent Application No. 5008286 states the following:

1. Claims 73, 88, 91, 94, 99, 103, 107, 112 and all claims depending from said claims are not allowed for protection because it is asserted that they relate to “an article comprising a machine-readable medium storing instructions for causing one or more processors to perform operations” which allegedly indicates an intent to protect a computer program. According to Mexican Law, computer programs and software are not considered as an invention and shall not be accepted.
2. The Office Action asserts that the claims do not refer to one single invention but to different groups of inventions as follows:
 - INVENTION 1: The current claims 1-28 and 60-72 refer to: managing digital rights using a digital wrapper and a license database.
 - INVENTION 2: The current claims 29-39 refer to: allocating proceeds in connection with a distribution of digital rights.

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- INVENTION 3: The current claims 40-48 refer to: facilitating digital rights management generating a digital key.
- INVENTION 4: The current claims 49-59 refer to: managing digital rights when transferring files.

The Office Action considers that these claims have different features and mean different inventions so they lack unity of invention.

3. Regarding claims 1, 60 and 63 which refer to “method for managing digital rights” and claims 29 and 34 which refer to a “method for allocating proceeds in connection with a distribution of digital rights,” according to Mexican Law, only one single claim per category is allowed.
4. The Office Action rejects claims 1-28 as lacking novelty and inventive step against the prior art document, to be called, D1: US2002/0161718, published 31/10/2002 due to the following:

The Office Action considers that D1 describes and claims the invention of claim 1 because it discloses and claims “A method for managing digital rights:”

- detecting a data file on a user device (paragraph 42; client application 103 is brought up).
- searching for information relating to an authorization to access the data file using data stored in a non-volatile storage area of the user device (paragraph 42; the agent module receives the request and queries the database to determine whether a license record exist that corresponds to the client application 103 and computer)
- information relating to an authorization to access the data file is included in an authorization database (paragraph 18: license server has a database)
- data stored in non-volatile storing area of users device including an access key (paragraph 18: hardware identifier on the computer)

- Access key is necessary for granting access to authorization data database (paragraph 43: presence of a record permits the client module 108 to allow continued operation of (i.e., re-enable(the software application);
- allowing access to data archive if an authorization is found during search (paragraph 43: presence of a record permits the client module 108 to allow continued operation of (i.e., re-enable), the software application).

This statement is being filed after a first Office action on the merits, but before receipt of a final Office action or a Notice of Allowance. Please apply the required \$180.00 filing fee as well as any other required fees or credits to PTO Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 21, 2008

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